

**REMARKS**

Claims 1, 3, 4, 12-45, 47-51, and 53-55 are pending in the instant application with claims 1, 23, 33, and 43 in independent form. Dependent claim 48 has been amended to correct an inadvertent grammatical error. Claims 2, 5-11, 46, and 52 were previously cancelled. No claims are currently added or cancelled. No new matter has been added through the present Amendment. Because no substantive amendments are currently made to the claims, and the only current amendment is to claim 48 to correct a grammatical error, the Applicants respectfully submit that the instant amendments are proper after final rejection, and the Applicants respectfully request the instant amendments to be entered.

Claims 1, 3, 4, 12-45, 47-51, and 53-55 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Horacek et al. (USPN 4,389,454) in view of Applicants' admitted prior art. The Applicants respectfully submit that the finality of the instant rejections is premature. Nonetheless, the Applicants also respectfully traverse the new rejections issued by the Examiner on the basis that the Applicants have made no admission that urethane-based paint compositions and water-based compositions are substitutable alternatives to each other, and no inferences to this effect can properly be made by the Examiner to reject the instant claims such that the Examiner's rejections that rely on Applicants' alleged admitted prior art are in error. The Applicants further submit that the instant invention as claimed would not be obvious in view of the prior art to Horacek et al. because Horacek et al. is only applicable to and functional for urethane-based compositions and one of skill in the art would not reasonably have been taught to include alkali metal hydroxide in a water-based composition based upon the teachings of Horacek et al.

As set forth above, the Applicants respectfully submit that the instant Office Action has improperly been made final. In particular, the Applicants respectfully submit that none of the amendments previously made to the claims provided a basis for the Examiner to make final any new rejections of the claims on the basis that Applicants' amendments to the claims necessitated such new rejections. As set forth in MPEP 706.07(c), “[a] second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations **which should reasonably have been expected to be claimed.**” (Emphasis added). The Applicants respectfully submit that original independent claims 23 and 33 claimed a paint composition comprising a water-based latex composition, and claims 23 and 33 were previously examined by the Examiner along with the rest of the claims in the instant application. The Applicants note that the only amendments made to the claims in the previous Amendment were amendments that replaced a previously-claimed “paint” composition in independent claims 1 and 43 (as well as the claims that depend therefrom) with a “water-based latex” composition, with independent claims 23 and 33 (as well as the claims that depend therefrom) amended only to bring those claims into consistent format with amended independent claims 1 and 43. The Applicants respectfully submit that the Examiner should reasonably have expected the previously-claimed paint composition comprising a water-based latex composition to be claimed in the manner now claimed in independent claims 1, 23, 33, and 43. In view of this fact, and because the Examiner has issued new rejections in which the Examiner has relied upon Applicants' alleged admitted prior art, the Applicants respectfully submit that the Examiner

is premature to make final the new rejections of the claims. Thus, the Applicants respectfully request the Examiner to withdraw the finality of the new rejections.

As also set forth above, the Applicants respectfully traverse the new rejections issued by the Examiner on the basis that the Applicants have made no admission that urethane-based paint compositions and water-based compositions are substitutable alternatives, and no inferences to this effect can properly be made by the Examiner to establish rejections of the instant claims. To explain, the Applicants recognize that under some circumstances, statements made in the Applicants' specification may be deemed admissions as to prior art. Applicants' statements that amount to admissions of prior art are set forth in MPEP 2129; however, none of the conditions set forth in MPEP 2129 for finding Applicants' statements an admission of prior art can be found in the instant application with regard to substitutable equivalence of urethane-based paint compositions and water-based latex compositions. While certain inferences may occasionally be inferred through Markush-type claiming methodologies, **there is no Markush relationship set forth in the instant application relative to urethane-based compositions and water-based latex compositions.** In fact, the structure of the instant application makes it **abundantly clear** that the Applicants were very careful to prevent water-based latex compositions from being read as a substitutable equivalent to urethane-based compositions. To explain, the original claims previously broadly claimed a paint composition. As a further definition of the paint composition, **separate claims were included to further specify the paint composition as comprising a water-based latex composition (see original claim 8) or other types of compositions (see original claims 9-11).** Such separate claiming strategies clearly illustrate the fact that the

Applicants did not intend for the various types of claimed compositions to be interpreted as substitutable equivalents. Further, the specification of the instant application clearly addresses water-based latex compositions separately from all other types of compositions (see paragraph [0018] in the original application as filed), and water-based latex compositions are even indicated as preferable to all other types of compositions. As such, the Applicants respectfully submit that the Examiner is in error by finding that the Applicants have admitted water-based latex compositions to be a substitutable equivalent to urethane-based compositions.

The Examiner is also reminded of the general prohibition of utilizing an Applicant's own disclosures to establish rejections. In fact, as set forth in MPEP 2129, even if labeled as "prior art," even the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. As such, the Applicants respectfully submit that the Examiner has erred by relying upon the specification of the instant application in issuing the instant rejections of the claims, especially because the Applicants have not even explicitly represented that urethane-based compositions and water-based latex compositions are substitutable equivalents.

With regard to Applicants' previous arguments that alkali metal hydroxides are included in the composition of Horacek et al. for a different purpose than the purpose for which alkali metal hydroxides are included in the instantly claimed water-based latex compositions, the Examiner has responded that advantages naturally flowing from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Notwithstanding the above arguments that prove that the

Applicants have **not** admitted water-based latex compositions and urethane-based compositions to be substitutable equivalents, especially for purposes of the instant invention, the Applicants respectfully submit that the subject differences in purposes is very relevant in the instant circumstances because such differences illustrate **why** one of skill in the art with knowledge of the teachings of Horacek et al. would **not** reasonably be taught to practice the instant invention as claimed because the underlying reasons for practicing the teachings of Horacek et al. are absent from the instantly claimed invention.

Again, Horacek et al. teaches molded polyurethane parts that have a lightfast polyurethane skin. The lightfast polyurethane skin is formed by applying a reaction mixture comprising a polyisocyanate, a polyol, and other components to the inside wall of a molding tool (see the Abstract of Horacek et al.). Once the lightfast polyurethane skin has solidified, a foamable polyurethane is introduced into the molding tool to produce a molded part in a very short cycle time (see column 3, lines 2-6 of Horacek et al.). One of the other components that is included in the reaction mixture that is used to form the lightfast polyurethane skin is an alkali metal hydroxide such as sodium hydroxide (see column 7, line 9 of Horacek et al.). As is apparent from the above, and with further reference to column 2, line 52 to column 3, line 6, fast solidification or cure of the lightfast polyurethane skin is the focal point of the invention described in Horacek et al. The fast cure of the lightfast polyurethane skin provides many advantages including short cycle times, resistance of the reaction mixture to running off the side walls of the molding tool, etc. In this regard, it is notable that the alkali metal hydroxides are disclosed in Horacek et al. as a catalyst that can be included in the reaction mixture that is used to form the lightfast polyurethane skin to

greatly accelerate the reaction of the polyols and the isocyanates therein (see column 6, line 45 to column 7, line 20). As such, it is clear that the **only** purpose for including the alkali metal hydroxide in the reaction mixture used to form the lightfast polyurethane skin in Horacek et al. is to accelerate the reaction between the polyol and the isocyanate therein. Because the alkali metal hydroxide is only disclosed as useful for including in the lightfast polyurethane skin to accelerate the reaction of the polyols and isocyanates therein, the Applicants respectfully submit that no reasonable argument can be made that one of skill in the art would be taught to include alkali metal hydroxide in a composition that has no polyols or isocyanates present therein (neither of which are required to be present in the instantly claimed water-based latex compositions).

Also notable is the fact that water is **not** present in the reaction mixture that is used to form the lightfast polyurethane skin of Horacek et al. As known in the art, any water present in such a composition would undergo a blowing reaction with the isocyanate contained in the reaction mixture and would result in a foamed structure of the lightfast polyurethane skin rather than an elastomeric (non-foamed) skin, which is clearly undesirable in the context of Horacek et al.

It is further notable that, in the context of the instant independent claim 1, the alkali metal hydroxide is infused in the water-based latex compositions that are used to form the paint layer. As readily known in the art, a latex is any emulsion in water of finely divided particles of synthetic rubber or plastic. Water-based latex compositions as claimed herein are clearly **not** reaction mixtures akin to the reaction mixtures used to make the lightfast polyurethane skins of Horacek et al. To further highlight this fact, it is noted that the alkali

metal hydroxide is **not** included in the water-based latex compositions of the instantly claimed invention for purposes of catalyzing a reaction therein, but is rather included to promote adhesion between the paint layer formed from the water-based latex composition and a polyurethane composition that is applied thereto to form a polyurethane layer (refer to paragraph [0008] on pages 2 and 3 of the original application as filed). In this regard, excellent adhesion is achieved between the paint layer and the polyurethane layer.

The Applicants respectfully submit that the aforementioned points of distinction between the instantly claimed invention and the teachings of Horacek et al. support the Applicants' position that one of skill in the art would not have reasonably been expected to have been able to arrive at the instant invention based on the teachings of Horacek et al., either alone or with the supposed admitted prior art. In particular, without a polyol and isocyanate required to be present in the water-based latex compositions of the instant claims, there would be no reason, based on the teachings of Horacek et al., to include alkali metal hydroxides in such compositions.

In view of the foregoing, the Applicants respectfully submit that independent claim 1, as well as the claims that depend therefrom, is both novel and non-obvious over Horacek et al., either alone or with the supposed admitted prior art, such that this claim is in condition for allowance, and the Applicants respectfully request the Examiner to reconsider the instant rejections. Independent claims 23, 33, and 43, while containing different elements than independent claim 1, still claim the same essential elements of claim 1 that provide the basis for differentiation from the teachings of Horacek et al. As such, the

Applicants respectfully submit that independent claims 23, 33, and 43, as well as the claims that depend therefrom, are both novel and non-obvious over Horacek et al.

This Amendment is timely filed and it is believed that no fees are presently due. However, the Commissioner is authorized to charge our deposit account no. 08-2789 for any additional fees or credit the account for any overpayment.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS PLLC**

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/Christopher S. Andrzejak/  
**Christopher Andrzejak, Reg. No. 57,212**  
450 West Fourth Street  
Royal Oak, MI 48067-2557  
(248) 723-0438